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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,906	10/30/2003	Akihiko Takeda	Q78005	5662
23373	7590	12/07/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			HON, SOW FUN	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

205

Office Action Summary	Application No.	Applicant(s)	
	10/695,906	TAKEDA ET AL.	
	Examiner	Art Unit	
	Sow-Fun Hon	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-42 is/are pending in the application.
- 4a) Of the above claim(s) 24-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/05 has been entered.

Election/Restrictions

2. Newly submitted claims 24-41 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 24-41, drawn to a method, classified in class 430, subclass 127.
- II. Claim 42, drawn to a spacer, classified in class 428, subclass 1.55.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the spacer can be formed by a method which further comprises an extra step of adding a light-sensitizer to the resin composition to

Art Unit: 1772

enhance the efficiency of the photodevelopment step, and another extra step of adding a heat-sensitizer to the resin composition to enhance the efficiency of the curing step.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Since applicant has received an action on the merits for the originally presented invention i. e. spacer, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if the photosensitive transfer material which comprises the temporary support, alkali-soluble thermoplastic resin layer, interlayer, and the photosensitive resin layer arranged in this order is attached to the receptor upon applying the photosensitive resin layer to the receptor, and whether the step of removing the unexposed portions in the photosensitive resin layer using an alkaline aqueous solution also removes the alkali-soluble thermoplastic resin layer as well,

Art Unit: 1772

leaving the interlayer still attached to the exposed portions of the photosensitive resin layer. Clarification is requested.

Claim Rejections - 35 USC § 102/103

7. Claim 42 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki (US 6,191,184).

Suzuki teaches a spacer (column 21, lines 45-50) formed from a resin composition for a spacer, the resin composition comprising: at least one resin selected from (1) a resin containing at least an allyl group (poly(allyl methacrylate, column 20, line 9), (2) a resin containing at least an allyl group and a hydroxyl group (poly(allyl methacrylate/methacrylic acid), column 20, line 9), and (3) a resin mixture containing an allyl-containing resin (poly(allyl methacrylate, column 20, line 9) and a hydroxyl-containing resin (poly(acrylic acid/hydroxyethyl methacrylate, column 20, lines 5-10); a polymerizable monomer (dipentaerythritol hexaacrylate, column 20, line 12); and a polymerization initiator (2-benxyl-2-dimethylamino-1-(morpholinophenyl)-butanone-1, column 20, lines 12-13 and column 15, lines 50-51), wherein the resin composition for a spacer is a photo-polymerizable resin composition (photo-setting, column 1, lines 60-64).

Suzuki fails to teach that the spacer is formed by a method comprising: applying the photosensitive resin layer to a receptor, wherein the photosensitive resin layer is part of a photosensitive transfer material, as defined by Applicant, comprising a temporary support, an alkali-soluble thermoplastic resin layer, an interlayer, and the

Art Unit: 1772

photosensitive resin layer arranged in this order; peeling the temporary support off from the alkali-soluble thermoplastic resin layer; exposing the photosensitive resin layer to radiation, and removing unexposed portions in the photosensitive resin layer using an alkaline aqueous solution, and curing the exposed portions. However, even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113 [R-1].

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number (571)272-1492. The examiner can normally be reached Monday to Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571)272-1498. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/695,906

Page 6

Art Unit: 1772

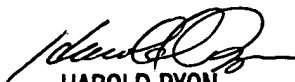
you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

S. Hon.

Sow-Fun Hon

12/02/05


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/5/05